



Mattel, Inc. v. MCA Records, Inc. 296 F.3D (9th Cir. 2002)

Heather Wallack

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CASE SUMMARY

MATTEL, INC. V. MCA RECORDS, INC.

296 F.3D 894 (9TH CIR. 2002)

I. INTRODUCTION

In *Mattel, Inc. v. MCA Records, Inc.*, the United States Court of Appeals for the Ninth Circuit ruled against Mattel, Inc., the maker of the famous Barbie dolls and owner of the Barbie trademark, concerning its claims of trademark use, confusion, dilution, and unfair competition.¹ The Ninth Circuit affirmed the United States District Court for the Central District of California decision granting summary judgment in favor of music companies associated with a band that used the word “Barbie” in a song.² The Ninth Circuit also affirmed the district court’s decision granting summary judgment in favor of Mattel, Inc. concerning a defamation claim asserted by the music companies.³ In addition, the United States Court of Appeals for the Ninth Circuit affirmed the district court’s holdings concerning jurisdictional claims made by the music companies.⁴

II. BACKGROUND

In the spring of 1997, a Danish band named Aqua released a song titled “Barbie Girl.”⁵ This song and its music video included lyrics to which Mattel, Inc. (“Mattel”) objected.⁶ The band

1. 296 F.3d 894 (9th Cir. 2002).

2. *Id.*

3. *Id.*

4. *Id.*

5. *Mattel, Inc. v. MCA Records, Inc.*, 28 F. Supp. 2d 1120, 1125 (C.D. Cal 1998).

6. *Id.* at 1126.

presented the song as if Barbie and Ken (the male companion to Barbie) sang the lyrics.⁷ The Barbie character sang lyrics which included, “undress me everywhere,” “I’m a blond bimbo girl, in a fantasy world”, “you can touch, you can play, if you say ‘I’m always yours,” and “make me talk, do whatever you please, I can act like a star, I can beg on my knees.”⁸ The Ken character sang lyrics which included, “kiss me here, touch me there, hanky panky” and “come jump in, bimbo friend, let us go do it again, hit the town, fool around, let’s go party.”⁹ Mattel objected to the adult themes intimated in the lyrics because they contradicted the wholesome image Mattel promotes in connection with Barbie dolls.¹⁰ Mattel also asserted that the song was not about the doll, therefore it could not be considered a parody.¹¹

In the fall of 1997, Mattel sued the record companies connected to the “Barbie Girl” song, namely, MCA Records, Inc., Universal Music International Ltd., Universal Music A/S, MCA Music Scandinavia AB, and Universal Music & Video Distribution, Inc. (“MCA”).¹² Mattel sought a preliminary injunction to halt production and distribution of the “Barbie Girl” song and video based on claims of trademark infringement, unfair competition and trademark dilution.¹³ Mattel also wanted the United States District Court for the Central District of California to order MCA to, “dispose of or destroy any product or its packaging, which uses Mattel’s BARBIE trade name.”¹⁴

In the United States District Court for the Central District of California, Mattel argued that MCA “misappropriated the Barbie trademark by using the word ‘Barbie’ in a way that would confuse

7. *Id.* at 1137.

8. *Id.*

9. *Id.*

10. *Mattel*, 28 F. Supp. 2d at 1125.

11. *Id.*

12. *Id.* at 1126.

13. *Mattel, Inc. v. MCA Records, Inc.*, No. CV 97-6791-WMB, 1998 U.S. Dist. LEXIS 7310, at *4 (C.D. Cal. February 19, 1998).

14. *Id.*

consumers and damage the Barbie product line.”¹⁵ MCA responded by claiming the “Barbie Girl” song was a parody of an American icon, and such parody receives protection under the First Amendment.¹⁶

MCA asserted, “the Barbie doll has become an icon that means different things to different people.”¹⁷ MCA stated that the doll represented views at polar ends of spectrums concerning feminism, chastity, and intelligence. Additionally, MCA noted that the doll was both praised and criticized for her physical image.¹⁸ MCA also identified nine other songs that used the Barbie name in connection with lyrics that were much more indecent than those in Aqua’s “Barbie Girl.”¹⁹

The United States District Court for the Central District of California adopted the view that the song was, “intended as a parody of both the doll itself and the values she has come to represent.”²⁰ The court also recognized that the members of the band did not physically resemble Barbie and Ken dolls.²¹ The court acknowledged that while the set of the video might be reminiscent of Barbie accessories, such a set was compatible with the band’s intended use of the song as parody.²²

When Mattel argued that the song infringed upon the Barbie federal trademark, trade name and trade dress, and caused consumer confusion, MCA responded that the trademark rights of Mattel were not so expansive to reach a song that parodied Mattel’s product.²³ The United States District Court for the Central District of California recognized the Barbie doll as distinctive, having acquired “secondary meaning.”²⁴ However, the

15. *Id.* at *6.

16. *Id.*

17. *Id.* at *11.

18. *Mattel*, 1998 U.S. Dist. LEXIS 7310, at *11.

19. *Id.* at *11-12.

20. *Id.* at *4 n.4.

21. *Id.* at *10.

22. *Id.*

23. *Mattel*, 1998 U.S. Dist. LEXIS 7310 at *13-14.

24. *Id.* at *14-16.

court noted that trademark rights are not limitless.²⁵ The court stated that trademark rights do “not allow trademark holders to censor or silence all discussions of their products that they find annoying or offensive.”²⁶ The court cautioned that, “although the First Amendment does not prevent trademark law from applying to artistic works, courts must be careful not to trample on free speech values in protecting trademarks.”²⁷

While normally an eight-factor test is used to determine likelihood of confusion concerning trademark infringement, MCA asserted that their limited use of the word “Barbie” classified the song “outside the trademark context.”²⁸ The United States District Court for the Central District of California applied a three-point test established in *New Kids on the Block v. News America Publ’g, Inc.* to determine whether MCA could be a “commercial user. . .entitled to a nominative fair use defense,” and concluded that MCA might have a defense to trademark infringement claims.²⁹

The United States District Court for the Central District of California determined that the song was a parody and therefore was protected by the First Amendment.³⁰ The court balanced the First Amendment interest of MCA while considering the traditional eight-factor likelihood of confusion test.³¹ The court concluded that Mattel would not likely succeed in establishing consumer confusion under the traditional test.³² Also, while the court acknowledged that there may be some incidental confusion because of the parody, it concluded that the First Amendment

25. *Id.*

26. *Id.* at *16.

27. *Id.* at *16-17.

28. *Mattel*, 1998 U.S. Dist. LEXIS 7310 at *17.

29. *Mattel*, 1998 U.S. Dist. LEXIS 7310 at *4, *21-26, (C.D. Cal. February 19, 1998) citing *New Kids on the Block v. News America Publ’g, Inc.*, 971 F.2d 302, 308 (9th Cir. 1992).

30. *Id.* at *31.

31. *Id.* at *32; *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979).

32. *Mattel*, 1998 U.S. Dist. LEXIS 7310 at *4, *46, (C.D. Cal. February 19, 1998).

interests involved weighed against granting a preliminary injunction.³³

Next, the United States District Court for the Central District of California addressed Mattel's claims of dilution. Mattel argued that the "Barbie Girl" song tarnished the Barbie trademark since the song implied adult themes in its lyrics that contradicted the wholesome image Mattel promotes in connection with its Barbie doll.³⁴ MCA, however, reasoned that the song fell within the "non-commercial use of a mark" exception to the federal dilution statute, and that First Amendment principles protected the use of the Barbie trademark by MCA.³⁵ The court recognized that even if use of the word "Barbie" by MCA did not fall under the statutory exception, the song was a parody, which enjoyed First Amendment protection.³⁶ The court concluded that unless Mattel could provide more evidence of tarnishment, it would be unlikely to prevail on its trademark dilution claims.³⁷

After Mattel filed its lawsuit, Mattel and MCA exchanged words publicly.³⁸ MCA was upset over Mattel's characterization of MCA's actions concerning the Barbie controversy.³⁹ MCA responded to the comments made by Mattel by filing a counterclaim for defamation.⁴⁰

In February 1998, the United States District Court for the Central District of California ultimately denied Mattel's motion for a preliminary injunction.⁴¹ Subsequent to the February 1998 decision, MCA moved for summary judgment, and sought to dismiss the foreign defendants over jurisdictional and forum matters.⁴² Also, Mattel moved for reconsideration of the denial of

33. *Id.*

34. *Id.* at *48-49.

35. *Id.* at *49.

36. *Id.* at *52.

37. *Id.*

38. *Mattel*, 28 F. Supp. 2d at 1159.

39. *Id.*

40. *Id.*

41. *Id.* at 1126.

42. *Id.*

the preliminary injunction, and it moved for summary judgment to dismiss MCA's defamation claims.⁴³

With regard to the jurisdictional and forum claims, MCA sought to dismiss the foreign defendants for lack of personal jurisdiction, subject matter jurisdiction, and forum non conveniens.⁴⁴ The United States District Court for the Central District of California concluded it had personal jurisdiction, subject matter jurisdiction, and that the choice of forum by Mattel was appropriate.⁴⁵

With regard to the defamation claim, MCA was disturbed by comments made by Mattel. Mattel, in attempting to draw an analogy to the actions of MCA related to the lawsuit, used terms such as "bank robber," "heist," "crime," and "theft."⁴⁶ The United States District Court for the Central District of California concluded that the statements made by Mattel were merely "hyperbole made in the middle of an attempt to convince the public of Mattel's side in the ongoing litigation."⁴⁷

The United States District Court for the Central District of California recognized that there was additional protection for statements made about a public figure, however, MCA claimed that it was not a public figure.⁴⁸ The court observed that voluntary actions of MCA while trying to "thrust itself into the forefront of the dispute with Mattel" enabled MCA to be considered a public figure for the purposes of a related defamation action.⁴⁹ Mattel and MCA argued over the sufficiency of evidence to prove that malice was present.⁵⁰ The court concluded that MCA failed to meet its high burden to prove its defamation claim against Mattel.⁵¹

In August 1998, The United States District Court for the Central District of California addressed the claim by Mattel of unfair

43. *Mattel*, 28 F. Supp. 2d at 1126.

44. *Id.*

45. *Id.* at 1126-32.

46. *Id.* at 1159.

47. *Id.* at 1161.

48. *Mattel*, 28 F. Supp. 2d at 1162.

49. *Id.*

50. *Id.* at 1163.

51. *Id.* at 1164.

competition under the Paris Convention.⁵² Mattel asserted that it had a federal cause of action that was separate from those available under the Lanham Act.⁵³ The court indicated that the Paris Convention allowed foreign plaintiffs to assert federal causes of action.⁵⁴ The court also recognized that, “the Paris Convention does not create ‘private rights under American law for acts of unfair competition occurring in foreign countries,’”⁵⁵ so it did not, “create substantive law distinct from the trademark law of individual nations.”⁵⁶ The court concluded that to the extent that Mattel was trying “to apply the Convention to the foreign defendants’ acts (in the United States), the Convention did not create a separate cause of action distinct from those already provided under federal law.”⁵⁷

III. DISCUSSION

Both Mattel and MCA appealed to the United States Court of Appeals for the Ninth Circuit. MCA appealed two aspects of the decision of the United States District Court for the Central District of California. Its first appeal concerned the jurisdictional holdings, and its second appeal concerned the granting of summary judgment to Mattel regarding MCA’s defamation claim.⁵⁸

Mattel appealed four aspects of the decision of the United States District Court for the Central District of California: (1) there was no likelihood of confusion concerning use of the word “Barbie” by the named music companies; (2) the song “Barbie Girl” was a parody of Barbie and considered nominative fair use; (3) there was

52. *Id.* at 1159.

53. *Mattel*, 28 F. Supp. 2d at 1157.

54. *Mattel*, 28 F. Supp. 2d at 1158 (quoting *Maison Lazard Et Compagnie v. Manfra Tordella & Brooks, Inc.*, 585 F. Supp. 1286, 1289 (S.D. N.Y. 1988)).

55. *Mattel*, 28 F. Supp. 2d at 1158 (quoting *Contractors v. Santa Fe Int’l Corp.*, 582 F. Supp. 445, 455 (C.D.Cal. 1984)) (quoting *Vanity Fair Mills v. T. Eaton Co.*, 234 F.2d 633, 640 (2nd Cir. 1956)).

56. 28 F. Supp. 2d at 1158.

57. *Id.* at 1158.

58. *Id.*

no dilution concerning use of the word “Barbie” by the named music companies; and (4) assertion of an unfair competition claim under the Paris Convention for the Protection of Industrial Property was not available to Mattel.⁵⁹

In July 2002, the United States Court of Appeals for the Ninth Circuit denied the appeals of both Mattel and MCA, and affirmed the holdings of the United States District Court for the Central District of California.⁶⁰

A. Jurisdictional Holdings

There were two jurisdictional holdings at issue before the United States Court of Appeals for the Ninth Circuit. The first holding concerned the personal jurisdiction over the foreign music companies named as defendants, namely, Universal Music International Ltd., Universal Music A/S, and MCA Music Scandinavia AB.⁶¹ The court observed that these music companies worked together to distribute and promote the “Barbie Girl” song in the United States.⁶² The court recognized that the music companies allegedly harmed Mattel in California, which was Mattel’s principal place of business.⁶³ The court reasoned that the intentional actions in the United States caused Mattel to file the lawsuit.⁶⁴ The court noted the close relationships among all of the defendants, foreign and domestic, and noted they were all represented by the same counsel.⁶⁵ The United States Court of Appeals for the Ninth Circuit affirmed the United States District Court for the Central District of California decision to assert personal jurisdiction over the foreign defendants.⁶⁶

The second jurisdictional holding concerned the jurisdiction of

59. *Id.*

60. *Mattel*, 296 F.3d 894 (9th Cir. 2002).

61. *Id.* at 899.

62. *Id.*

63. *Id.*

64. *Id.*

65. *Mattel*, 296 F.3d at 899.

66. *Id.*

the United States District Court for the Central District of California under the Lanham Act.⁶⁷ The United States Court of Appeals for the Ninth Circuit reasoned that the international sales of the album that included the “Barbie Girl” song sufficiently impacted American foreign commerce, and those sales resulted in Mattel experiencing monetary damages domestically.⁶⁸ The court noted that the trademark infringement and dilution claims of Mattel were related more to American foreign commerce than to international commerce.⁶⁹ The court supported its position by noting that California was the principal place of business for Mattel, that Mattel was only seeking relief concerning domestic sales by MCA, and although there were foreign defendants, those defendants had close relationships with the domestic defendants.⁷⁰ The United States Court of Appeals for the Ninth Circuit concluded that extraterritorial jurisdiction under the Lanham Act was proper.⁷¹

B. Trademark

1. Likelihood of Confusion

Mattel appealed the United States District Court for the Central District of California’s decision granting summary judgment concerning Mattel’s likelihood of confusion claim in favor of MCA.⁷² The United States Court of Appeals for the Ninth Circuit instructed that a trademark is used as a source-identifier for providers of goods and services.⁷³ It stated that since the purpose of trademarks is very limited, “a trademark owner’s property rights

67. *Id.*

68. *Id.*

69. *Id.*

70. *Mattel*, 296 F.3d at 899-900.

71. *Id.* at 900.

72. *Id.* at 899.

73. *Id.* at 900.

play well with the First Amendment.”⁷⁴ The court, however, recognized that problems exist when, “trademarks transcend their identifying purpose.”⁷⁵ It noted that some trademarks have fallen into the every-day vocabulary of the public, such as Band-Aid or Aspirin, and when this happens, the trademark “assumes a role outside the bounds of trademark law.”⁷⁶

The United States Court of Appeals for the Ninth Circuit declared that it typically addressed a trademark issue concerning a likelihood of consumer confusion by applying a test set forth in *AMF Inc. v. Sleekcraft Boats*.⁷⁷ The court said, however, that such a test was not adequate to balance against, “the full weight of the public’s interest in free expression.”⁷⁸ The court recognized the limits on trademark owners by indicating that they, “do not have the right to control public discourse whenever the public imbues his mark with a meaning beyond its source-identifying function.”⁷⁹ The court addressed whether the “Barbie Girl” song was a parody before ruling on the likelihood of confusion claim.

2. Parody and Fair Use

Mattel also appealed the United States District Court for the Central District of California decision that the song Barbie Girl was a parody of Barbie and considered nominative fair use.⁸⁰ The United States Court of Appeals for the Ninth Circuit recognized that while MCA obviously used the Barbie trademark in its “Barbie Girl” song, the title described the underlying work, namely, a song about Barbie or a girl similar to Barbie.⁸¹

The song “Barbie Girl” made fun of Barbie and the values she

74. *Id.*

75. *Mattel*, 296 F.3d at 900.

76. *Id.*

77. *Id.*; 599 F.2d 341, 348-49 (9th Cir. 1979).

78. *Mattel*, 296 F.3d at 900.

79. *Id.*

80. *Id.* at 899.

81. *Id.* at 901.

had come to represent to Aqua, the band singing the song.⁸² The United States Court of Appeals for the Ninth Circuit made the distinction that “the song does not rely on the Barbie mark to poke fun at another subject but targets Barbie herself.”⁸³ The court distinguished the parody found in “Barbie Girl” from a book entitled *The Cat NOT in the Hat!* that incorporated a protected work of Dr. Seuss. The court recalled that in *Dr. Seuss*, it ruled that “*The Cat NOT in the Hat!* borrowed Dr. Seuss’s trademarks and lyrics to get attention rather than to mock *The Cat in the Hat!*”, and as a result *The Cat NOT in the Hat!* was not afforded First Amendment protection against trademark infringement.⁸⁴ The Ninth Circuit recalled the *Dr. Seuss* court declaration that, “where an artistic work targets the original and does not merely borrow another’s property to get attention, First Amendment interests weigh more heavily in the balance.”⁸⁵

With regard to a standard of review, the United States Court of Appeals for the Ninth Circuit looked to the United States Court of Appeals for the Second Circuit for guidance.⁸⁶ The Second Circuit recognized in *Rogers v. Grimaldi* that consumers, “do not regard titles of artistic works in the same way as the names of ordinary commercial products.”⁸⁷ In *Rogers*, actress Ginger Rogers objected to a film entitled *Ginger and Fred* that involved two dancers who imitated Ginger Rogers and Fred Astaire.⁸⁸ She argued that the public would mistakenly associate her with the film.⁸⁹ The *Rogers* court determined that the Lanham Act was not violated by literary titles, “unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or the

82. *Id.*

83. *Mattel*, 296 F.3d at 901

84. *Id.* at 901; *Dr. Seuss Ents., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394 (9th Cir. 1997).

85. *Mattel*, 296 F.3d at 901.

86. *Id.*

87. *Mattel*, 296 F.3d at 901 (quoting *Rogers* 875 F.2d 994, 999).

88. *Id.*

89. *Id.*

content of the work.”⁹⁰

In applying the *Rogers* standard to the case at hand, the United States Court of Appeals for the Ninth Circuit recognized that use of Barbie in the title “Barbie Girl” described the underlying work.⁹¹ While MCA used the Barbie mark, the song parodied Barbie and the values she had come to represent to the band singing the song. The court further recognized that the “Barbie Girl” title “does not explicitly mislead as to the source of the work; it does not, explicitly or otherwise, suggest that it was produced by Mattel.”⁹²

The United States Court of Appeals for the Ninth Circuit affirmed the view that the “Barbie Girl” song was a parody in nature.⁹³ The court concluded that MCA was properly granted summary judgment on the grounds concerning the likelihood of confusion.

3. *Dilution*

Mattel appealed the United States District Court for the Central District of California ruling that there was no dilution concerning use of the word “Barbie” by the named music companies.⁹⁴ Mattel argued that under the Federal Trademark Dilution Act, the “Barbie Girl” song diluted the Barbie mark in two ways.⁹⁵ First, it claimed that the song, “diminishes the mark’s capacity to identify and distinguish Mattel products.”⁹⁶ Second, it claimed the song, “tarnishes the mark because the song is inappropriate for young girls.”⁹⁷ The United States Court of Appeals for the Ninth Circuit contrasted dilution and trademark infringement by stating, “the injury from dilution usually occurs when consumers *aren’t*

90. *Id.* at 902 (quoting *Rogers* 875 F.2d 994, 999).

91. *Id.* at 901.

92. *Mattel*, 296 F.3d at 902.

93. *Id.* at 901.

94. *Id.* at 899.

95. *Id.* at 902.

96. *Id.*

97. *Mattel*, 296 F.3d at 902-03.

confused about the source of a product.”⁹⁸

The United States Court of Appeals for the Ninth Circuit discussed the significance of the adoption of the Federal Trademark Dilution Act in 1996.⁹⁹ The court identified that the Act offered statutory protection for, “the owner of a famous mark. . . against another person’s commercial use in commerce of a mark or trade name, if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark.”¹⁰⁰

The United States Court of Appeals for the Ninth Circuit recognized use of the Barbie trademark by MCA as dilutive since the Barbie mark was famous and MCA participated in commerce for its own gain with goods that identified the same Barbie mark.¹⁰¹ The court highlighted the evidence of blurring which took place since the success of “Barbie Girl” song, in that consumers may now associate the Barbie mark with more than just the doll.¹⁰²

The United States Court of Appeals for the Ninth Circuit noted that while dilutive use of trademarks is prohibited, there are three statutory exceptions to this rule.¹⁰³ These exceptions include comparative advertising, news reporting and commentary, and noncommercial use.¹⁰⁴ The court applied the third exception concerning noncommercial use, and noted that the other two categories were inapplicable to the case.¹⁰⁵

The United States Court of Appeals for the Ninth Circuit reconciled its finding that there was commercial use of the “Barbie Girl” song under the first part of the statute concerning the determination of dilution, with its subsequent evaluation of whether the song fell under a noncommercial use exception.¹⁰⁶

98. *Id.* at 903.

99. 15 U.S.C. § 1125(c) (1996), *see e.g.* 296 F.3d at 903.

100. *Mattel*, 296 F.3d at 903; 15 U.S.C. § 1125(c).

101. *Mattel*, 296 F.3d at 903.

102. *Id.* at 903-04.

103. *Id.* at 904.

104. *Id.*

105. *Id.*

106. *Mattel*, 296 F.3d at 904.

The court sought to interpret the statute in a manner that preserved maximum First Amendment protection for dilutive speech provided in the statute.¹⁰⁷

The United States Court of Appeals for the Ninth Circuit differentiated trademark injunctions from dilution injunctions. It first addressed the scope of the injunctions. The court stated a trademark injunction is usually very narrow in scope since it addresses the confusion concern in one or a few industries, whereas a dilution injunction is much broader since it addresses the association of the mark with unrelated goods and services.¹⁰⁸

The United States Court of Appeals for the Ninth Circuit also contrasted the purpose of trademark injunctions and dilution injunctions. It recognized that consumer protection is a consideration with a trademark injunction, which is consistent with the First Amendment, and not a consideration for a dilution injunction.¹⁰⁹ The court acknowledged that, “dilution law protects only the distinctiveness of the mark, which is inherently less weighty than the dual interest of protecting trademark owners and avoiding harm to consumers.”¹¹⁰

The United States Court of Appeals for the Ninth Circuit referred to the legislative history of the Federal Trademark Dilution Act for guidance in resolving its dilemma.¹¹¹ The court noted that Congress was cognizant of “the potential collision with the First Amendment if the statute authorized injunctions against protected speech.”¹¹² As a result, Congress trusted that the “noncommercial use” exception would alleviate the First Amendment concerns.¹¹³ The “noncommercial use” as used in the statutory exception, therefore “refers to a use that consists entirely of noncommercial, or fully constitutionally protected, speech.”¹¹⁴

107. *Id.*

108. *Id.* at 904-05.

109. *Id.* at 905.

110. *Id.*

111. *Mattel*, 296 F.3d at 905.

112. *Id.*

113. *Id.* at 906.

114. *Mattel*, 296 F.3d at 905.

The United States Court of Appeals for the Ninth Circuit then evaluated whether the “Barbie Girl” song qualified under the “noncommercial use” exemption by reviewing its prior decisions concerning commercial speech and the First Amendment.¹¹⁵ The court recalled a statement made in its prior decision of *Hoffman v. Capital Cities/ABC, Inc.*, that, “if speech is not purely commercial. . .if it does more than propose a commercial transaction—then it is entitled to full First Amendment Protection.”¹¹⁶

In *Hoffman*, a magazine promoted itself by altering images of popular films, including an image of the actor Dustin Hoffman in his role in the film “Tootsie.”¹¹⁷ The image was altered so that he appeared to be dressed in current high fashion.¹¹⁸ Dustin Hoffman sued under the Lanham Act and for violation of his right to publicity since he had not provided permission for such use.¹¹⁹ In *Hoffman*, the Ninth Circuit decided that although the purpose of the subject work was commercial, it incorporated expression, so it was therefore protected under the First Amendment.¹²⁰

The United States Court of Appeals for the Ninth Circuit applied its holding in *Hoffman* to the case at hand.¹²¹ The court concluded that similar to the image in the magazine in *Hoffman*, the “Barbie Girl” song was protected since it “lampoons the Barbie image and comments humorously on the cultural values Aqua claims she represents.”¹²² The song, therefore, was considered noncommercial use and an exception to the Federal Trademark Dilution Act.¹²³

115. *Id.* at 906.

116. *Id.* at 906 (citing *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1185-86 (9th Cir. 2001)).

117. *Mattel*, 296 F.3d at 906.

118. *Id.*

119. *Id.*

120. *Id.*

121. *Id.*

122. *Mattel*, 296 F.3d at 906-07.

123. *Id.* at 907.

4. *Unfair Competition Claim*

Mattel appealed the United States District Court for the Central District of California assertion that an unfair competition claim against the foreign defendants under the Paris Convention for the Protection of Industrial Property was not available to Mattel.¹²⁴ Mattel claimed that an article under the Paris Convention for the Protection of Industrial Property created “a federal cause of action for unfair competition in international disputes and that Section 44 of the Lanham Act makes the substantive provisions of the Paris Convention available to United States nationals.”¹²⁵

The Court of Appeals for the Ninth Circuit clarified issues that were identified in *Toho Co. v. Sears, Roebuck & Co.*¹²⁶ In *Toho*, a foreign national was protected against unfair competition under section 44 of the Lanham Act.¹²⁷ Provisions under section 44 allowed this protection to the foreign national since its country of origin was a signatory to a trademark convention or treaty that the United States also signed. The court noted that “the only protection under unfair competition that subsection 44(h) granted to foreign nationals, and subsection 44(i) therefore grants to American citizens, is that which is, ‘necessary to give effect to any provisions of [trademark treaties].’”¹²⁸

The court recalled its holding in *Kemart Corp v. Printing Arts Research Labs, Inc.* where the Paris Convention was not found to have defined substantive law concerning unfair competition as it related to the countries which signed the Convention.¹²⁹ The Paris Convention instead leveled the playing field to ensure an equality of treatment of parties by member countries.¹³⁰ The court concluded that the Paris Convention did not provide Mattel with more protections against foreign nationals than it had against

124. *Id.* at 899.

125. *Id.* at 907.

126. 645 F.2d 788, 790-92 (9th Cir. 1981).

127. *Mattel*, 296 F.3d at 907.

128. *Id.* at 908; 15 U.S.C. § 1126(b).

129. *Mattel*, 296 F.3d at 908; 269 F.2d 375, 389 (9th Cir. 1959).

130. *Mattel*, 296 F.3d at 908.

American nationals.¹³¹ The Ninth Circuit clarified that it was treating Mattel “like a foreign national, who is treated like an American under the Paris Convention,”¹³² and concluded that Mattel had “no claim to a nonexistent federal cause of action.”¹³³

C. Defamation

MCA appealed the United States District Court for the Central District of California’s decision granting summary judgment concerning MCA’s defamation claim in favor of Mattel.¹³⁴ The United States Court of Appeals for the Ninth Circuit considered Mattel’s use of terms such as “bank robber,” “heist,” “crime,” and “theft” to describe the actions of MCA.¹³⁵ The United States Court of Appeals for the Ninth Circuit recognized that use of such terms was just a substitute for Mattel claiming piracy by MCA.¹³⁶ The court observed that “no one hearing this accusation understands intellectual property owners to be saying that infringers are nautical cutthroats with eyepatches and peg legs who board galleons to plunder cargo,”¹³⁷ and went on to describe use of such terms by Mattel as “nonactionable rhetorical hyperbole.”¹³⁸ The court therefore affirmed the United States District Court for the Central District of California decision granting summary judgment in favor of Mattel, Inc. concerning the defamation claim.

IV. Conclusion

Ruth Handler, the creator of the Barbie doll and co-founder of Mattel, launched Barbie into the toy market in 1959.¹³⁹ When she

131. *Id.*

132. *Id.*

133. *Id.*

134. *Id.* at 899.

135. *Mattel*, 296 F.3d at 908.

136. *Id.*

137. *Id.*

138. *Id.* at 908 (quoting *Gilbrook v. City of Westminster*, 177 F.3d 839, 863 (9th Cir. 1999)).

139. Barbie Doll Creator Dies, available at <http://news.bbc.co.uk/1/hi/world/americas/1956180.stm>. (last visited December 12, 2002).

did so, she created not just a toy but a cultural icon. Although its creator passed away in April, 2002,¹⁴⁰ the Barbie doll and its trademark will undoubtedly continue. As the doll and trademark endure, however, Mattel is informed of the limits on how far it can go with claiming trademark rights when the First Amendment is involved, as established by the United States Court of Appeals for the Ninth Circuit in *Mattel, Inc. v. MCA Records, Inc.*¹⁴¹

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140. *Id.* (Ruth Handler was forced out of Mattel in the late 1970's).

141. *Mattel*, 296 F.3d at 906.